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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/509,073 08/22/00 PIETRAS

B MRKS/0012

EXAMINER

PM82/0914

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HAWKINS GAY, J

ART UNIT

PAPER NUMBER

3672

DATE MAILED:

09/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/509,073

Applicant(s)

PIETRAS ET AL.

Examiner

Jennifer H Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-16 and 26-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-16 and 26-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stator recited in claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 34. Correction is required.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 36, 216, and 217. Correction is required.

Specification

4. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.

- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

5. The disclosure is objected to because of the following informalities: on page 6, line 11, "20" should be changed to --30--.

The disclosure is further objected to because page 2, line 7 and page 3, lines 1 and 2 recite that further features of the invention are "set out" in claims 2-14 and 18-24. Throughout the prosecution of the application the claims may change or be canceled altering the meaning of the specification. Thus, these statements should be deleted and the features recited in the above claims added in their place to avoid any future confusion.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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7. Claims 1, 3-9, and 14-16 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 98/11322.

WO 98/11322 discloses a device for connecting pieces of pipe to form a casing string. The device includes a body (9 and 10) connected to a top drive within a derrick and an inflatable elastomeric gripping member (11). The top drive system includes an elevator for supporting the casing string. The gripping member functions not only to grip the inside of the pipe but as a sealing packer to prevent fluid from flowing between the device and the casing. The body of the device includes a longitudinal passage through its length and a pair of smaller flow passages (19 and 20) within the larger, longitudinal passage. The smaller passages are used to pressurize the annulus (18) between the device and the casing (passage 19) and to inflate the gripping member (passage 20). The longitudinal passage allows fluid to flow into the casing below the gripping member. (See pages 5-7 and Figures 1 and 6)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 12, 26-32, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/11322 in view of Delano .

WO 98/11322 discloses all of the limitations of the above claims except for the upper portion of the body including spline recesses and the gripping member having blades.

Delano discloses an apparatus used to run casing into a wellbore. The apparatus includes an upper slip section (44), a middle tong section (46), and a lower seal section (48). The upper section includes a series of blade shaped slip sections (126 and 128) that are controlled by a pressure sensitive piston (146) and a spring

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(150). The upper portion of the slip section includes a set of spline recesses that engage the splines on a conduit (68) that connects to apparatus to the traveling block. The middle section contains a plurality of tong dies (168 and 170) that are forced into engagement with the casing wall by a camming mechanism (180). The lower section includes a packer (186) and a series of guides (192) that aid in stabbing in the casing. (See col. 3, lines 1-15, col. 4, lines 45-67, col. 5, lines 1-60, and Figures 1-4)

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the spline recesses of Delano on the device of WO 98/11322 in order to have been able to easily detach and replace the device when necessary. Further, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the blade slips of Delano on the device of WO 98/11322 in order to have provided a more secure means for gripping the casing.

10. Claims 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/11322 in view of Boyadejeff and Albright et al.

WO 98/11322 discloses all of the limitations of the above claims except for the casing support being carried by pneumatically operated weight-compensating pistons.

Boyadejeff discloses a well drilling apparatus that includes a top drive (20), an elevator (118), a swivel (31), and a hydraulic compensating piston/cylinder system (110). The swivel allows fluid to be supplied to the cylinders by the gooseneck (33) and includes bearings within the connection between the swivel and a portions of a connecting rod (34) of the piston/cylinder system. The cylinder of the system (57) is connected to the drill string by lower external threads (59). The apparatus further includes a spring means to urge the system upward (see col. 3, lines 1-20). (See col. 5, lines 50-67, col. 8, lines 5-45, and Figures 2 and 10-12)

Albright et al. discloses a wellbore tubular compensator system. The system includes a weight compensating piston/cylinder assembly that is controlled by either hydraulically or pneumatically. (See col. 9, lines 30-55)

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the tubing support system of Boyadejeff in conjunction with the weight compensating pistons of Albright et al. with the pipe connecting device of WO 98/11322 in order to have been able to use the device with pipes of various lengths, thus weights, without overloading the system (see col. 1, lines 60-65 of Albright et al.).

Regarding claim 13, WO 98/11322 discloses all of the limitations of the above claims except for bearings between the tubing support and the body of the device. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the swivel system with bearings of Boyadejeff to support the device and casing of WO 98/11322 in order to have not only supported the tubing but allowed the tubing and device to rotate freely.

11. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/11322 in view of Delano as applied to claim 29 above, and further in view of Boyadejeff and Albright et al.

WO 98/11322 and Delano disclose all of the limitations of the above claims except for the casing support being carried by pneumatically operated weight-compensating pistons. Boyadejeff teaches a tubing support system that includes compensating pistons. Albright et al. teaches a weight compensation system that includes pistons that are controlled either hydraulically or pneumatically. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the tubing support system of Boyadejeff in conjunction with the weight compensating pistons of Albright et al. with the pipe connecting device of WO 98/11322 in view of Delano in order to have been able to use the device with pipes of various lengths, thus weights, without overloading the system (see col. 1, lines 60-65 of Albright et al.).

Response to Arguments

12. In view of the applicant's amendment, the 35 USC 112.2 rejection of claims 1-14 has been withdrawn. However, the objections to the Drawings and Specification have been repeated since they were not addressed in the amendment.

13. Applicant's arguments filed 2 August 2001 have been fully considered but they are not persuasive.

In response to applicant's argument that Gjebedo does not teach at least one gripping element radially displaced by hydraulic or pneumatic fluid, the examiner disagrees. The inflatable element taught in the above reference is used to grip the inside walls of a tubular and is radially expanded by pneumatic fluid.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay, formally Jennifer M Hawkins, whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Friday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-7687 for regular communications and (703) 306-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

JHG 
September 12, 2001


DAVID BAGNELL
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